



DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Agency Information Collection Activities; Submission to the Office of Management and Budget (OMB) for Review and Approval; Comment Request; Rules for Patent Maintenance Fees

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice of information collection; request for comment.

SUMMARY: The United States Patent and Trademark Office (USPTO), in accordance with the Paperwork Reduction Act of 1995, invites comments on the extension and revision of an existing information collection: 0651–0016 (Rules for Patent Maintenance Fees). The purpose of this notice is to allow 60 days for public comment preceding submission of the information collection to OMB.

DATES: To ensure consideration, comments regarding this information collection must be received on or before [INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: Interested persons are invited to submit written comments by any of the following methods. Do not submit Confidential Business Information or otherwise sensitive or protected information.

- *Email:* InformationCollection@uspto.gov. Include “0651–0016 comment” in the subject line of the message.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.
- *Mail:* Kimberly Hardy, Office of the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Parikha Mehta, Patent Examination Policy Advisor, Office of Patent Legal

Administration, United States Patent and Trademark Office (USPTO), P.O. Box 1450, Alexandria, VA 22313– 1450; by telephone at 571–272–3248; or by email at Parikha.Mehta@uspto.gov with “0651–0016 comment” in the subject line. Additional information about this information collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

SUPPLEMENTARY INFORMATION:

I. Abstract

Under 35 U.S.C. § 41 and 37 CFR 1.20(e)-(h), 1.362, 1.363, 1.366, 1.377, and 1.378, the United States Patent and Trademark Office (USPTO) charges fees for maintaining in force all utility patents based on applications filed on or after December 12, 1980. Payment of these maintenance fees is due at 3 1/2, 7 1/2, and 11 1/2 years after the date the patent was granted. If the USPTO does not receive payment of the appropriate maintenance fee and any applicable surcharge within a grace period of six months following each of the above due dates (at 4, 8, or 12 years after the date of grant), the patent will expire at that time. After a patent expires, it is no longer enforceable. Maintenance fees are not required for design, plant, or reissue patents if the patent being reissued did not require maintenance fees.

Payments of maintenance fees that are submitted during the 6-month grace period before patent expiration must include the appropriate surcharge as indicated by 37 CFR 1.20(h). Submissions of maintenance fee payments and surcharges must include the relevant patent number and the corresponding United States application number in order to identify the correct patent and ensure proper crediting of the fee being paid.

If the USPTO refuses to accept and record a maintenance fee payment that was submitted prior to the expiration of a patent, the patentee may petition the Director to accept and record the maintenance fee under 37 CFR 1.377. This petition must be accompanied by the fee indicated in 37 CFR 1.17(g), which may be refunded if it is determined that the refusal to accept the maintenance fee was due to an error by the USPTO.

If a patent has expired due to nonpayment of a maintenance fee, the patentee may petition the Director to accept a delayed payment of the maintenance fee under 37 CFR 1.378. The Director may accept the payment of a maintenance fee after the expiration of the patent if the petitioner shows to the satisfaction of the Director that the delay in payment was unintentional. Petitions to accept unintentionally delayed payment must also be accompanied by the required maintenance fee and the petition fee as set forth in 37 CFR 1.17(m). If the Director accepts the maintenance fee payment upon petition, then the patent is reinstated. If the USPTO denies a petition to accept delayed payment of a maintenance fee in an expired patent, the patentee may petition the Director to reconsider that decision under 37 CFR 1.378(d).

The rules of practice (37 CFR 1.33(d) and 1.363) permit applicants, patentees, assignees, or their representatives of record to specify a “fee address” for correspondence related to maintenance fees that is separate from the correspondence address associated with a patent or application. A fee address must be an address that is associated with a USPTO customer number. Customer numbers may be requested by using the Request for Customer Number Form (PTO/SB/125), which is covered under OMB control number 0651-0035. Maintaining a correct and updated address is necessary so that fee-related correspondence from the USPTO will be properly received by the applicant, patentee, assignee, or authorized representative. If a separate fee address is not specified for a patent or application, the USPTO will direct fee-related correspondence to the correspondence address of record.

This information collection covers the forms needed to submit a patent maintenance fee payment (PTO/SB/45 and AIA/47) and to designate or change a fee address (PTO/SB/47). The USPTO also offers two different versions of the form for petitions to accept unintentionally delayed payment of maintenance fee in an expired patent under 37 CFR 1.378(b). In addition to the PDF version that may be completed electronically, the USPTO also offers a Web-based ePetition. Customers may also submit maintenance fee payments and surcharges incurred during the 6-month grace period before patent expiration by using the Maintenance Fee Transmittal

Form (PTO/SB/45) or by paying online through the USPTO's online Patent Maintenance Fees Storefront. However, to pay a maintenance fee after patent expiration, the maintenance fee payment and the petition fee, as set forth in 37 CFR 1.17(m), must be filed together with a petition to accept unintentionally delayed payment. The USPTO accepts online maintenance fee payments by credit card, deposit account, or electronic funds transfer (EFT). Otherwise, non-electronic payments may be made by check, credit card, or deposit account.

II. Method of Collection

Items in this information collection may be submitted via online electronic submissions. In limited circumstances, applicants may be permitted to submit the information in paper form by mail, fax, or hand delivery.

III. Data

OMB Number: 0651-0016.

Form Numbers:

- PTO/SB/45 (Maintenance Fee Transmittal Form)
- PTO/SB/47 ("Fee Address" Indication Form)
- PTO/SB/66 (Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(b)))

Type of Review: Extension and revision of a currently approved information collection.

Affected Public: Private sector; individuals or households.

Estimated Number of Respondents: 577,892 per year.

Estimated Number of Responses: 577,892 per year.

Estimated Time per Response: The USPTO estimates that it takes the public approximately 0.5 minutes (0.01 hours) to 8 hours to complete this information, depending upon the item. This includes the time to gather the necessary information, prepare and maintain the documents, and submit the items to the USPTO.

Estimated Total Annual Hour Burden: 12,945 hours.

Estimated Total Annual Cost Burden (Hourly): \$2,771,565.

Table 1: Burden Hour/Burden Cost to Respondents for Private Sector

Item No.	Item	Estimated Annual Respondents	Estimated Annual Responses (year) (a)	Estimated Time for Response (hours) (b)	Estimated Annual Burden (hour/year) (a) x (b) = (c)	Rate¹ (\$/hour) (d)	Estimated Annual Respondent Cost Burden (c) x (d) = (e)
1	Maintenance Fee Transmittal Transactions (PTO/SB/45)	9,923	9,923	0.08 (5 minutes)	794	\$145	\$115,130
2	Electronic Maintenance Fee Transactions	486,092	486,092	0.01 (0.5 minutes)	4,861	\$145	\$704,845
3	Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(b)) (PTO/SB/66)	2,288	2,288	1	2,288	\$400	\$915,200
4	Petition to Review Refusal to Accept Payment of Maintenance Fee Prior to Expiration of Patent (37 CFR 1.377)	1	1	4	4	\$400	\$1,600

¹ 2019 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPAL); <https://www.aipal.org/detail/journal-issue/2019-report-of-the-economic-survey>. The USPTO uses the mean rate for attorneys in private firms which is \$400 per hour. The hourly rate for paraprofessional/paralegals is estimated at \$145 from data published in the 2018 Utilization and Compensation Survey by the National Association of Legal Assistants (NALA)

Item No.	Item	Estimated Annual Respondents	Estimated Annual Responses (year) (a)	Estimated Time for Response (hours) (b)	Estimated Annual Burden (hour/year) (a) x (b) = (c)	Rate¹ (\$/hour) (d)	Estimated Annual Respondent Cost Burden (c) x (d) = (e)
5	Petition for Reconsideration of Decision on Petition Refusing to Accept Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(d))	121	121	8	968	\$400	\$387,200
6	“Fee Address” Indication Form (PTO/SB/47)	39,013	39,013	0.08 (5 minutes)	3,121	\$145	\$452,545
	Totals	537,438	537,438	---	12,036	---	\$2,576,520

Table 2: Burden Hour/Burden Cost to Respondents for Rules for Individuals or Households

Item No.	Item	Estimated Annual Respondents	Estimated Annual Responses (year) (a)	Estimated Time for Response (hours) (b)	Estimated Annual Burden (hour/year) (a) x (b) = (c)	Rate² (\$/hour) (d)	Estimated Annual Respondent Cost Burden (c) x (d) = (e)
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² 2019 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); <https://www.aipla.org/detail/journal-issue/2019-report-of-the-economic-survey>. The USPTO uses the mean rate for attorneys in private firms which is \$400 per hour. The hourly rate for paraprofessional/paralegals is estimated at \$145 from data published in the 2018 Utilization and Compensation Survey by the National Association of Legal Assistants (NALA)

Item No.	Item	Estimated Annual Respondents	Estimated Annual Responses (year) (a)	Estimated Time for Response (hours) (b)	Estimated Annual Burden (hour/year) (a) x (b) = (c)	Rate² (\$/hour) (d)	Estimated Annual Respondent Cost Burden (c) x (d) = (e)
1	Maintenance Fee Transmittal Transactions (PTO/SB/45)	747	747	0.08 (5 minutes)	60	\$145	\$8,700
2	Electronic Maintenance Fee Transactions	36,588	36,588	0.01 (0.5 minute)	366	\$145	\$53,070
4	Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(b)) (PTO/SB/66)	172	172	1	172	\$400	\$68,800
5	Petition to Review Refusal to Accept Payment of Maintenance Fee Prior to Expiration of Patent (37 CFR 1.377)	1	1	4	4	\$400	\$1,600

Item No.	Item	Estimated Annual Respondents	Estimated Annual Responses (year) (a)	Estimated Time for Response (hours) (b)	Estimated Annual Burden (hour/year) (a) x (b) = (c)	Rate ² (\$/hour) (d)	Estimated Annual Respondent Cost Burden (c) x (d) = (e)
6	Petition for Reconsideration of Decision on Petition Refusing to Accept Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(d))	9	9	8	72	\$400	\$28,800
7	“Fee Address” Indication Form (PTO/SB/47)	2,937	2,937	0.08 (5 minutes)	235	\$145	\$34,075
	Totals	40,454	40,454	---	909	---	\$195,045

Estimated Total Annual Cost Burden (Non-Hourly): \$1,586,634,038. This information collection has no capital start-up, maintenance, or operating fees. This information collection does have filing fees and postage costs. The filing fees are associated with the maintenance of patents, which are listed in the table below. The total non-hour respondent cost burden for this information collection in the form of filing fees (\$1,586,633,000) and postage costs (\$1,038) is approximately \$1,586,634,038.

Table 3: Filing Fees – Non-hour Cost Burden for Rules for Patent Maintenance Fees

Item No.	Item	Responses	Filing Fee	Burden \$
		(a)	(b)	(a) x (b) = (c)
1	For Maintaining an Original or Any Reissue Patent, Due at 3.5 Years (undiscounted entity)	220,200	\$2,000	\$440,400,000
1	For Maintaining an Original or Any Reissue Patent, Due at 3.5 Years (small entity)	49,000	\$1,000	\$49,000,000
1	For Maintaining an Original or Any Reissue Patent, Due at 3.5 Years (micro entity)	4,500	\$500	\$2,250,000
1	For Maintaining an Original or Any Reissue Patent, Due at 7.5 Years (undiscounted entity)	134,500	\$3,760	\$505,720,000
1	For Maintaining an Original or Any Reissue Patent, Due at 7.5 Years (small entity)	26,600	\$1,880	\$50,008,000
1	For Maintaining an Original or Any Reissue Patent, Due at 7.5 Years (micro entity)	1,500	\$940	\$1,410,000
1	For Maintaining an Original or Any Reissue Patent, Due at 11.5 Years (undiscounted entity)	63,800	\$7,700	\$491,260,000
1	For Maintaining an Original or Any Reissue Patent, Due at 11.5 Years (small entity)	9,200	\$3,850	\$35,420,000
1	For Maintaining an Original or Any Reissue Patent, Due at 11.5 Years (micro entity)	600	\$1,925	\$1,155,000
1	Surcharge – 3.5 year – Late Payment Within 6 Months (undiscounted entity)	3,600	\$500	\$1,800,000
1	Surcharge – 3.5 year – Late Payment Within 6 Months (small entity)	6,450	\$250	\$1,612,500

1	Surcharge – 3.5 year – Late Payment Within 6 Months (micro entity)	1,200	\$125	\$150,000
1	Surcharge – 7.5 year – Late Payment Within 6 Months (undiscounted entity)	2,550	\$500	\$1,275,000
1	Surcharge – 7.5 year – Late Payment Within 6 Months (small entity)	3,550	\$250	\$887,500
1	Surcharge – 7.5 year – Late Payment Within 6 Months (micro entity)	450	\$125	\$56,250
1	Surcharge – 11.5 year – Late Payment Within 6 Months (undiscounted entity)	1,450	\$500	\$725,000
1	Surcharge – 11.5 year – Late Payment Within 6 Months (small entity)	1,500	\$250	\$375,000
1	Surcharge – 11.5 year – Late Payment Within 6 Months (micro entity)	250	\$125	\$31,250
3	Petition for the Delayed Payment of the Fee for Maintaining a Patent in Force (undiscounted entity)	650	\$2,100	\$1,365,000
3	Petition for the Delayed Payment of the Fee for Maintaining a Patent in Force (small entity)	1,500	\$1,050	\$1,575,000
3	Petition for the Delayed Payment of the Fee for Maintaining a Patent in Force (micro entity)	300	\$525	\$157,500
	Totals	---	---	\$1,586,633,000

The public may submit the forms and petitions in this information collection to the USPTO by mail through the United States Postal Service. The USPTO estimates that the average

postage cost for a mailed submission, using a Priority Mail 2-day flat rate legal envelope, will be \$8.05. The USPTO estimates approximately 129 submissions per year may be mailed to the USPTO, for a total postage cost of \$1,038 per year.

Respondent's Obligation: Required to obtain or retain benefits.

IV. Request for Comments

The USPTO is soliciting public comments to:

- (a) Evaluate whether the proposed collection of information is necessary for the proper performance of the functions of the Agency, including whether the information will have practical utility;
- (b) Evaluate the accuracy of the Agency's estimate of the burden of the proposed collection of information, including the validity of the methodology and assumptions used;
- (c) Enhance the quality, utility, and clarity of the information to be collected; and
- (d) Minimize the burden of the collection of information on those who are to respond, including through the use of appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

All comments submitted in response to this notice are a matter of public record. USPTO will include or summarize each comment in the request to OMB to approve this information collection. Before including an address, phone number, email address, or other personal identifying information (PII) in a comment, be aware that the entire comment— including PII— may be made publicly available at any time. While you may ask in your comment to withhold PII from public view, USPTO cannot guarantee that it will be able to do so.

Kimberly Hardy,
Information Collections Officer,
Office of the Chief Administrative Officer,
United States Patent and Trademark Office.
[FR Doc. 2021-09035 Filed: 4/29/2021 8:45 am; Publication Date: 4/30/2021]